

Appl. No.: 10/715,202
Amdt. dated 10/25/2005
Reply to Office action of July 26, 2005

REMARKS

This amendment is responsive to the Official Action dated July 26, 2005. Applicant would like to thank the Examiner for a timely and thorough review of the above-referenced patent application. Claims 1-20 were previously pending in the application. Claims 1-20 have been rejected. Applicant respectfully traverses each of the rejections set forth in the Official Action. As described below, the cited references, alone or in combination, neither teach nor suggest the claimed invention. As such, Applicant submits that the present set of claims is in condition for allowance and respectfully requests reconsideration of the present application. Applicant has added new independent Claims 21 and 22.

The Official Action rejected Claims 1-3, 5-12 and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,289,084 B1 to William J. Bushnell ("Bushnell") in view of U.S. Publication No. 2002/0099846 A1 to Scott G. Hicks ("Hicks"). As explained below, Applicant respectfully submits that independent Claim 1, and by dependency dependent Claims 2-3, 5-12, and 14 are patentably distinct from the Bushnell and Hicks patents. Similarly, Applicant respectfully submits that independent Claim 15, and by dependency dependent Claims 16-20 are patentably distinct from the Bushnell and Hicks patents.

Initially, Applicants submit that the requisite motivation or suggestion for combining Hicks with Bushnell is lacking. In this regard, in order to properly combine references, a teaching or motivation to combine the references is essential. *In re Fine*, 337 F.2d 1071, 1075 (Fed. Cir. 1988). In fact, the Court of Appeals for the Federal Circuit has stated that, "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). Although the evidence of a suggestion, teaching, or motivation to combine the references commonly comes from the prior art references themselves, the suggestion, teaching, or motivation can come from the knowledge of one of ordinary skill in the art or the nature of the problem to be solved. *Id.* In any event, the showing must be clear and particular and "[b]road

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conclusory statements regarding the teaching effect of multiple references, standing alone, are not 'evidence'." *Id.*

The Official Action indicates that it would have been obvious to one of ordinary skill in the art to modify the apparatus of Bushnell with the disclosure by Hicks relating to forming a first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers. See Official Action, page 3. However, the Bushnell patent and the Hicks patent describe techniques with markedly different purposes. Bushnell discloses an apparatus and method for screening telephone calls, while Hicks discloses a method of storing e-mail addresses. Further, the Bushnell patent and the Hicks patent describe techniques that solve problems of a dramatically different nature. Bushnell discloses automatic telephone call screening "in accordance with the personal and tailored needs, tastes and preferences of the individual telecommunication consumer." Col. 1, line 67 – Col. 2, line 3. In contrast, Hicks discloses the storage of e-mail addresses in a removable memory device, such that the e-mail addresses may be transported from one mobile communications device to another. See ¶ 0035. As such, Applicant submits that one of ordinary skill in the art would not have been motivated to modify the apparatus of Bushnell with the disclosure of Hicks relating to forming a first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers.

For each of the foregoing reasons, Applicant submits that the Hicks patent may not properly be combined with the Bushnell patent. As such, the rejection of the claims is respectfully traversed. Even if the references were combined, however, the combination of the references still fails to teach or suggest the claimed invention. In this regard, the combination of references still fails to teach or suggest a calling-group listing formed of a first-group set of dialing numbers, with the first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers, as recited by independent Claims 1 and 15.

Independent Claim 1 is directed to a user interface apparatus for facilitating selectable call screening in a radiotelephonic device, while independent Claim 15 is directed to a method for facilitating selectable call screening. Claim 1 recites that the apparatus comprises a calling-group listing, a comparator, and a call acceptor. Claim 1 further recites that the calling-group listing is formed of a first-group set of dialing numbers, with the first-group set of dialing

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numbers corresponding to a speed-dial set of dialing numbers. The Official Action correctly recognizes that Bushnell does not disclose a user interface apparatus comprising a calling-group listing formed of a first-group set of dialing numbers, with the first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers. However, the Official Action asserts that Hicks discloses such a calling-group listing. Applicant respectfully disagrees with this assertion for at least the following reason.

Claims 1 and 15 recite that the calling-group listing is used to determine if an incoming call (i.e., a "terminating call") should be accepted, by determining if the originating dialing number of the incoming call matches one of the first-group set of dialing numbers that form the calling-group listing. Claims 1 and 15 further recite that the first-group set of dialing numbers corresponds to a speed-dial set of dialing numbers. While Hicks briefly mentions the existence of speed dial lists and screening lists (§§ 0003, 0005) which may arguably be analogous, respectively, to the speed-dial set and the calling-group listing of the present application, Hicks provides no additional teaching regarding these two features other than this brief mention. Specifically, Hicks neither teaches nor suggests a screening list that corresponds to a speed dial list, as recited in Claims 1 and 15. In fact, Hicks does not disclose any correspondence between a screening list and a speed dial list. Thus, neither Bushnell nor Hicks, alone or in combination, teaches or suggests a calling-group listing formed of a first-group set of dialing numbers, with the first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers, as recited by the claimed invention.

For each of the foregoing reasons, it is respectfully submitted that the rejection of independent Claims 1 and 15 is respectfully overcome. Since Claims 2-14 depend from independent Claim 1, and Claims 16-20 depend from independent Claim 15, these dependent claims are also patentably distinct from the combination of Bushnell and Hicks for at least the reasons described above.

The Official Action rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Bushnell in view of Hicks and further in view of U.S. Patent No. 6,751,485 to Jukka Ranta ("Ranta"). Applicant respectfully disagrees with this rejection. Ranta discloses a mobile telephone and associated method in which recently made, received, or missed telephone calls are

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stored in memory and associated with a distinctive alerting sound. As discussed above, neither Bushnell nor Hicks, alone or in combination, teaches or suggests a calling-group listing formed of a first-group set of dialing numbers, with the first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers, as recited by the claimed invention. Similarly, Ranta neither teaches nor suggests a calling-group listing formed of a first-group set of dialing numbers, with the first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers, as recited in Claim 1 and thus in Claim 4 by dependency. Ranta discloses comparing the telephone number of an incoming telephone call against a list of recently made, received, or missed telephone calls and against a list of pre-stored telephone numbers. Col. 6, lines 53-66. As such, Ranta may arguably be considered to disclose a screening list, similar to the calling-group list of the present application. However, Ranta does not disclose a speed-dial list, and as such cannot be said to teach or suggest any correspondence between the screening list and a speed-dial list. Thus, Bushnell, Hicks, and Ranta, alone or in combination, do not teach or suggest a calling-group listing formed of a first-group set of dialing numbers, with the first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers, as recited by the claimed invention. It is respectfully submitted, therefore, that Claim 4 is patentable over the combination of Bushnell in view of Hicks and further in view of Ranta.

The Official Action rejected Claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Bushnell in view of Hicks and further in view of U.S. Patent No. 6,741,688 to Hunyue Yau ("Yau"). Applicant respectfully disagrees with this rejection. Yau neither teaches nor suggests an alpha-numeric identifier associated with each of the dialing numbers of a first-group set forming a calling-group listing, as recited in Claim 13. Yau discloses an apparatus and method for processing incoming and outgoing telephone calls by comparing a telephone number to a stored template, with the stored template comprising a mask-identifying digit position criterion ("mask") and a target-identifying digit content criterion ("target"). The mask identifies which digit positions within a telephone number are deemed significant for processing purposes. Col. 3, lines 61-63. The target identifies specific values within those significant positions identified by the mask which are targeted for processing. Col. 4, lines 7-10. Yau discloses that the mask and the target are represented by alpha-numeric fields. Col. 11, lines 33-37. Yau indicates that

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each digit of a mask and each digit of a target are represented by an alpha-numeric field. *See* Col. 3, lines 57-61; Col. 4, lines 5-7. Thus, while Yau discloses alpha-numeric fields corresponding to the digits of a template against which a telephone number is compared, Yau neither teaches nor suggests an alpha-numeric identifier associated with each telephone number (i.e., dialing number) in a calling-group listing, as recited in Claim 13.

Further, as discussed above, neither Bushnell nor Hicks, alone or in combination, teaches or suggests a calling-group listing formed of a first-group set of dialing numbers, with the first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers, as recited in Claim 1 and thus in Claim 13 by dependency. Similarly, Yau neither teaches nor suggests a calling-group listing formed of a first-group set of dialing numbers, with the first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers. As discussed above, Yau discloses comparing a telephone number against a two part template, or screen. However, the template of Yau cannot reasonably be interpreted to be a calling-group listing as recited in Claim 1. The calling-group listing of Claim 1 comprises a group of telephone numbers against which an incoming call is compared. The template disclosed by Yau does not comprise a group of telephone numbers, but rather groups of alpha-numeric fields as discussed above. Additionally, Yau does not disclose a speed-dial list, and as such cannot be said to teach or suggest any correspondence between a calling-group listing and a speed-dial list. Thus, Bushnell, Hicks, and Yau, alone or in combination, do not teach or suggest a calling-group listing formed of a first-group set of dialing numbers, with the first-group set of dialing numbers corresponding to a speed-dial set of dialing numbers, as recited by the claimed invention.

It is respectfully submitted, therefore, that Claim 13 is patentable over the combination of Bushnell in view of Hicks and further in view of Yau.

For each of the reasons described above in conjunction with independent Claims 1 and 15 as well as the additional reasons set forth above in conjunction with particular dependent claims, Claims 1 and 15, as well as dependent Claims 2-14 and 16-20 are patentably distinct relative to the cited references. Thus, it is respectfully submitted that the rejection of Claims 1-20 is overcome.

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Claims 21 and 22 have been added to more particularly define other unique aspects of the claimed invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

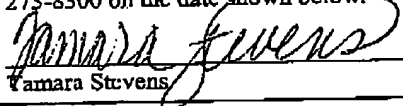


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Tamara Stevens

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Date